

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the Final Official Action of the Examiner mailed November 5, 2003. Claims 1-24 and 26 remain pending. Claim 25 has been canceled without prejudice as being drawing to a non-elected invention, and claim 26 is newly presented. Reconsideration, examination and allowance of all pending claims are respectfully requested.

The undersigned would like to thank the Examiner for the courtesies extended during the telephonic conference of January 12, 2003. Prior to this telephone conference, the undersigned sent a Proposed Amendment-After-Final similar to this Amendment-After-Final. During the telephone conference, the Examiner indicated that the undersigned should file an Amendment-After-Final, and in response, he would either allow the case or issue a new non-final Office Action.

As a preliminary matter, Applicants note that the present Office Action has been made Final. Applicant believes that the Finality of this Office Action is improper. As noted in MPEP § 706.07(a):

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

(Emphasis Added). In the present case, independent claim 16, and dependent claims 17-21 and 23 were not amended in Applicant's previous Amendment (filed on June 30, 2003), and these claims are

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

currently rejected under newly cited art. As such, and according to MPEP § 706.07(a), the Finality of this Office Action is improper, and Applicant respectfully requests that it be withdrawn.

Also, Applicant submitted three supplemental IDSs, including one on April 29, 2003, another on August 15, 2003, and yet another on December 16, 2003. ***Applicant respectfully requests that the Examiner consider these references, and provide initialed copies of the FORM-1449's filed therewith in due course.***

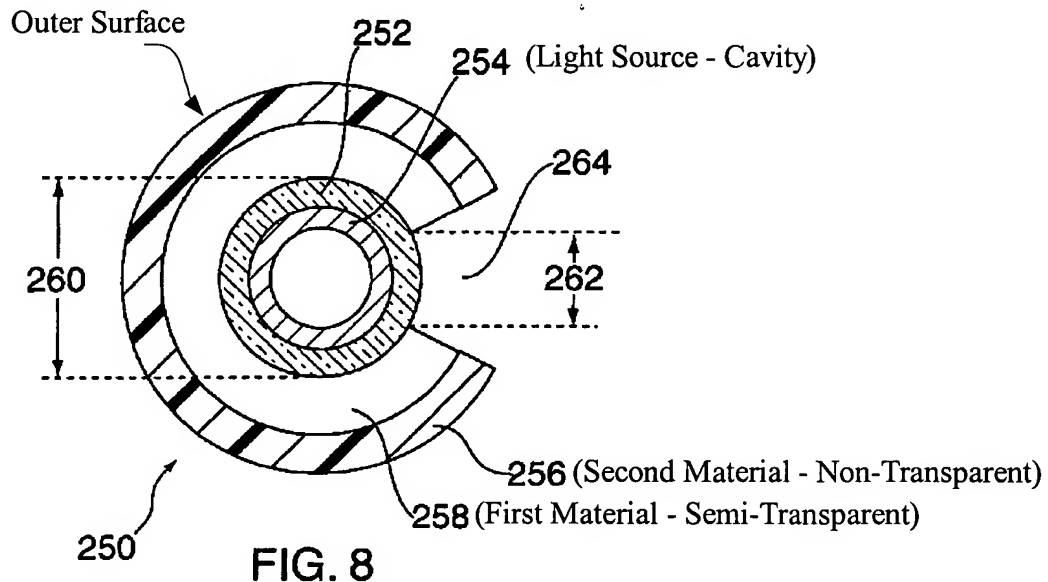
In paragraph 2 of the Office Action, the Examiner states that claim 25 is directed to an invention that is independent and distinct from the invention originally claimed. The Examiner states that since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original prosecution on the merits. As such, claim 25 has been withdrawn from further consideration as being directed to a non-elected invention. With this Amendment, Applicant has canceled claim 25 without prejudice.

In paragraph 4 of the Office Action, the Examiner rejected claims 1-4, 6-7, 9-11, 13-19 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over Zou et al. (U.S. Patent No. 6,186,649) in view of Sugiyama et al. (U.S. Patent No. 6,278,827). With regard to claims 1, 9-11 and 13-16, the Examiner states that Zou et al. suggest a lighting apparatus for receiving an elongated light source (citing 254 in Fig. 8) having an elongated member including a first material (citing 258 in Fig. 8) and a second material (citing 256 in Fig. 8), the first material being at least semi-transparent (citing column 8, line 48) and the second material being substantially non-transparent (citing column 8, line 42), the elongated member having a cavity (citing 254).

With respect to claim 1, it appears that the Examiner may be ignoring some of the language of claim 1. Claim 1 recites:

1. (Previously Presented) A lighting apparatus for receiving an elongated light source, comprising:
a monolithic elongated member including a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material that extends from the cavity to an outer surface of the elongated member.

(Emphasis Added). To help illustrate this point, Applicant has replicated Figure 8 of Zou et al. below, with annotations added that correspond to the Examiner's remarks.



As can clearly be seen, Figure 8 of Zou et al. does not have a cavity 254 that is at least partially defined by at least a portion of the first material 258 that extends from the cavity 254 to an outer surface of the elongated member 250 (Emphasis Added). Instead, the first material 258 of Figure 8

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

of Zou et al. is completely surrounded or encased by the second non-transparent material 256, and does not extend to an outer surface of the elongated member 250. Applicant notes that the Examiner cannot ignore this claim language, and must produce art that shows by itself or in combination each and every element of the claim.

Applicant also respectfully disagrees that it would have been obvious to employ the multi-material extrusion molding machine of Sugiyama in order to make Zou's monolithic elongated member. Sugiyama does not appear to provide any sort of cavity, and in particular, a cavity for receiving an elongated light source. Thus, the relevance of Sugiyama is diminished. In addition, there is no suggestion whatsoever in either Sugiyama or Zou et al. to make the proposed combination. In view of the foregoing, claim 1 is believed to be clearly patentable over Zou et al. in view of Sugiyama et al. For similar and other reasons, dependent claims 2-12 and 24 are also believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

Turning now to claim 13, which recites:

13. (Previously Presented) A lighting apparatus for receiving an elongated light source, comprising:
a first elongated piece;
a second elongated piece;
at least a portion of the first elongated piece being transparent or semi-transparent;
at least a portion of the second elongated piece being substantially non-transparent;
the first elongated piece and the second elongated piece defining a cavity for receiving the elongated light source; and
at least one of the first elongated piece and the second elongated piece having an elongated slit along at least part of its length that extends between the cavity and the exterior of the lighting apparatus, the slit adapted to facilitate insertion and/or extraction of the elongated light source into/from the cavity along

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

a length of the lighting apparatus.

As can be seen, claim 13 recites that the first elongated piece and the second elongated piece define a cavity for receiving the elongated light source, wherein at least a portion of the first elongated piece is transparent or semi-transparent and at least a portion of the second elongated piece is substantially non-transparent. As detailed with respect to claim 1, and as can be seen in annotated Figure 8 of Zou et al. provided above, the cavity is completely defined by the first transparent material 258. As such, claim 13 is believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

Claim 13 also recites that at least one of the first elongated piece and the second elongated piece have an elongated slit along at least part of its length that extends between the cavity and the exterior of the lighting apparatus, wherein the slit is adapted to facilitate insertion and/or extraction of the elongated light source into/from the cavity along a length of the lighting apparatus (Emphasis Added). Applicant has not found a single reference in Zou et al. that suggests that the opening 264 in Figure 8 is adapted to facilitate insertion and/or extraction of the elongated light source into/from the cavity along a length of the lighting apparatus. Rather, it appears that the cavity 254 of Zou et al. of Figure 8 is formed by disposing the first and second materials directly over the light source, and thus the light source is fixed or encased in the first and second materials. For these and other reasons, claim 13 is believed to be clearly patentable over Zou et al. in view of Sugiyama et al. For similar and other reasons, dependent claims 14-15 are also believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

Turning now to claim 16, which recites:

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

16. (Unchanged) A method for making an elongated member for receiving an elongated light source, the method comprising the steps of:
co-extruding an elongated member with a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material that extends from the cavity to an outer surface of the elongated member.

As can be seen, claim 16 recites co-extruding an elongated member with a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material that extends from the cavity to an outer surface of the elongated member. For similar reasons to those discussed above, as well as other reasons, claim 16 is believed to be clearly patentable over Zou et al. in view of Sugiyama et al. For similar and other reasons, dependent claims 16-23 are also believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

Specifically with respect to claims 2 and 17, the Examiner states that Zou et al. suggests that the cavity is at least partially defined by at least a portion of the second material. This is simply not the case. Referring to annotated Figure 8 above, the second material 256 does not at least partially define the cavity 254. Rather, the cavity 254 appears to be completely defined by the first transparent material 258. Thus, for these additional reasons, dependent claims 2 and 17 are believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

Specifically with respect to claims 6 and 21, the Examiner states that Zou et al. suggests a

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

surface shaped as a lens (citing 202 in Figure 6). However, reference numeral 202 of Figure 6 of Zou et al. is a light source, and not a lens. For example, Zou et al. state:

Another embodiment of this invention is shown as linear illumination source 200 in FIG. 6 (a cross-sectional view) and FIG. 7 (a perspective view). In this embodiment, the linear light source 202 having a width 210 is embedded into the side of the external reflective enclosure 204 which has a maximum inside width.

(Emphasis Added)(Zou et al., column 7, line 66 through column 8, line 4). If the Examiner elects to maintain this rejection, Applicant respectfully requests that the Examiner specifically point out where Zou et al. discloses a first material that includes a surface that is shaped as a lens.

Specifically with respect to claims 7 and 22, the Examiner states that Zou et al. suggests an elongated slit between the cavity and the exterior of the elongated member (citing 264 in Fig. 8). As noted above, Applicant has not found a single reference in Zou et al. that suggests that the opening 264 in Figure 8 is adapted to facilitate insertion and/or extraction of the elongated light source into/from the cavity along a length of the lighting apparatus. Rather, and as discussed above, it appears that the cavity 254 of Figure 8 of Zou et al. is formed by disposing the first and second materials over the light source, and that the light source is then fixed or encased in the first and second materials. Thus, for these additional reasons, dependent claims 7 and 22 are believed to be clearly patentable over Zou et al. in view of Sugiyama et al.

In paragraph 5 of the Office Action, the Examiner rejected claims 5 and 20 under 35 U.S.C. §103(a) as being unpatentable over Zou et al. The Examiner acknowledges that Zou et al. does not disclose that the reflective surface is parabolic in shape. However, the Examiner states that Zou et al.

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

suggests that the external enclosure can have any cross-sectional shape including circular, elliptical, oval, etc. (citing Zou et al., column 7, line 3). The Examiner then states that Zou's elliptical shape is an art-recognized equivalent at the time the invention was made, and one of ordinary skill in the art would have found it obvious to substitute a parabolic shape.

For the reasons discussed above with respect to independent claims 1 and 16, as well as other reasons, dependent claims 5 and 20 are believed to be clearly patentable over Zou et al. In addition, however, Applicant respectfully disagrees that it would have been obvious to substitute a parabolic shape for the circular, elliptical, oval, etc. shape of Zou et al. With reference to Figures 4 and 5, Zou et al. states that the linear opening 158 preferably has a maximum width 164 that is less than the maximum inside width 162 of the external reflective enclosure 154. Zou et al. further state that more preferably, the maximum width 164 of linear opening 158 ranges from about 3% to about 75% of the maximum inside width 162 of the external reflective enclosure. (see, Zou et al., column 7, lines 3-8).

Thus, the external reflective enclosure 154 of Figures 4-5 of Zou et al. preferably extends around most of the light source. It is difficult to see how one skilled in the art could make the external reflective enclosure 154 a parabolic shape and still achieve a maximum width 164 of linear opening 158 between about 3% to about 75% of the maximum inside width 162 of the external reflective enclosure.

In addition, there is no evidence whatsoever in the record that a parabolic shape is an art-recognized equivalent of a circular, elliptical, oval, etc. shape, as asserted by the Examiner. The reflecting properties of a parabolic shape can be substantially different than for circular, elliptical, or

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

oval shapes. Thus, if the Examiner elects to maintain this rejection, Applicant respectfully requests that the Examiner provide evidence that a parabolic shape is an art-recognized equivalent of a circular, elliptical, oval, etc. shape when applied to a reflector. For the foregoing reasons, as well as other reasons, claims 5 and 20 are believed to be clearly patentable over Zou et al.

In paragraph 6 of the Office Action, the Examiner rejected claims 12 and 24 under 35 U.S.C. §103(a) as being unpatentable over Zou et al. With respect to claim 12, the Examiner acknowledges that Zou et al. does not disclose that the light source is a linear emitting fiber or glow-in-the-dark material. However, the Examiner states that Zou et al. suggests linear lighting sources such as electro-luminescent strips (citing Zou et al., column 4, lines 61-62). The Examiner then states that Zou's electro-luminescent strips were an art-recognized equivalent at the time the invention was made, and one of ordinary skill in the art would have found it obvious to substitute a linear emitting fiber or glow-in-the-dark material for the linear light source. Applicant respectfully disagrees. There is no evidence of record that suggests that an electro-luminescent strip is an art-recognized equivalent to a linear emitting fiber or a glow-in-the-dark material. Linear emitting fibers, as well as glow-in-the-dark materials, operate substantially different than electro-luminescent strips. For example, both linear emitting fibers and glow-in-the-dark materials do not require an electric current along their length to deliver or produce light, and thus they operate in a substantially different way from an electro-luminescent strip. If the Examiner elects to maintain this rejection, Applicant respectfully requests that the Examiner provide evidence that an electro-luminescent strip was an art-recognized equivalent to a linear emitting fiber or a glow-in-the-dark material.

Application No. 10/074,162
Amendment dated January 14, 2004
Reply to Final Office Action dated November 5, 2003

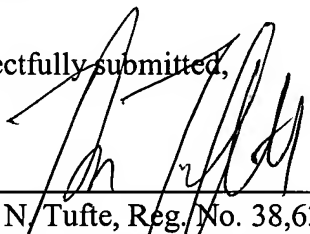
In paragraph 7 of the Office Action, the Examiner objected to claims 8 and 23 as being dependent upon a rejected base claim, but that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Since independent claims 1 and 16 are believed to be in condition for allowance, dependent claims 8 and 23 are also believed to be in condition for allowance.

Finally, Applicant has added newly presented claim 26. For similar reasons to those given above, as well as other reasons, newly presented claim 26 is believed to be clearly in condition for allowance.

In view of the foregoing, Applicant believes that all pending claims 1-24 and 26 are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the undersigned attorney at (612) 573-2002.

Dated: January 14, 2004

Respectfully submitted,



Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349